

REMARKS

This Amendment and Response is filed in connection with a Request for Continued Examination and in response to the Final Office Action mailed on December 18, 2006.

Claims 1-10 were amended, no claims are canceled; as a result, claims 1-10 are now pending in this application.

§103 Rejection of the Claims

Claims 1-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the 1997 Broadcast of "Schindler's List" on NBC in view of Matheny et al. (U.S. Patent No. 6,766,524; hereinafter "Matheny").

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness, because even if combined, the cited references fail to teach or suggest all of the claim limitations of the independent claims of the present Application.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Applicant continues to assert that the previously submitted claims with the limitations including, "without commercial interruption" distinguish over Matheny, the 1997 Broadcast of "Schindler's List" on NBC, and all other art of record. However, the claims have been amended herein to further distinguish the claimed invention from the art of record. Specifically, amended Claim 1 includes the following limitation:

"...at a predetermined time and without viewer interaction, sending said stored embedded information and viewer information to a remote computer to allow said remote computer to construct said viewing record..." (Emphasis Added)

The Office Action contended that the previously submitted limitation of, "...at a predetermined time, sending said stored embedded information and viewer information to a remote computer to allow said remote computer to construct said viewing record..." is

taught/suggested by the Matheny. Specifically, the Office Action referenced Figures 2 and 4 of Matheny as teaching this limitation.

Matheny is directed at a system and method for encouraging viewers to watch television programs. As described in Matheny,

...viewers are notified that they can receive frequent-flier miles for answering one or more simple questions at the conclusion of the commercial. To verify that the viewer paid attention to the commercial, the answer to the question may be based on the content of the commercial. A sponsor might ask, for example, that the viewer identify the name of the sponsor or the color of an announcer's shirt. A correct answer indicates that the viewer watched the commercial, and that the viewer is therefore entitled to some reward... (Matheny Abstract) (emphasis added).

In other embodiments, viewers need not provide a "correct" answer, but may be rewarded for merely participating in the interactive program. Such participation may include selecting an icon with a pointing device, pressing one or more buttons on a remote control, or sending an email message to a location identified in the program. (Matheny Summary) (emphasis added).

In accordance with the invention, broadcaster 205 notifies viewers of television set 235 that they may be rewarded for paying attention to a current or upcoming program, typically a commercial. Later, viewers are presented a question, the answer to which is based upon the content of the program. Viewers that provide the correct answer are entitled to the reward. The identities of viewers who provide correct answers to the question are therefore forwarded to server 220, within which is maintained a database of viewers and corresponding earned entitlements. (Matheny Detailed Description, 3rd paragraph) (emphasis added)

The possibility of receiving a reward will entice some viewers to claim rewards without bothering to watch the associated commercial. Thus, in accordance with one embodiment of the invention, viewers must provide some feedback to indicate that they watched the commercial before they are entitled to a reward. In the example of FIG. 2, set-top box 245 presents the viewer with a test question 265 at or near the end to the commercial. The question is based upon the content of the commercial, so viewers who watch the commercial are able to answer the question correctly. In the example depicted as a subsequent video frame 266 of television 235, a reward query 265 prompts the viewer with a query 269 asking the viewer to enter the previously displayed cruise destination into a form field 270. Entering the correct answer in field 270 entitles a viewer to the offered reward. (Matheny Detailed Description, 6th paragraph) (emphasis added)

Broadcasters may wish to pose questions for which there are no correct answers. For example, a sponsor may wish to ask survey questions. The invention may be adapted to provide rewards to viewers who answer such questions. Further, some viewers may find filling in blanks too cumbersome; thus, other embodiments employ simpler test methods (e.g., multiple-choice or true/false), or reward viewers for merely participating in interactive programs. Such participation may include selecting an icon with a pointing device or pressing one or more buttons on a remote control. Still other embodiments may demand more information from a viewer, such as by prompting the viewer to send an email message to a location identified in the program, and possibly by requiring the viewer fill out an electronic form. (Matheny Detailed Description, 7th paragraph) (emphasis added)

As these passages from Matheny indicate, Matheny is directed at a system and method that requires some sort of viewer interaction as part of the reward validation and fulfillment process. As described in Matheny, “viewers must provide some feedback to indicate that they watched the commercial before they are entitled to a reward”. As such, Matheny is designed and implemented to require such viewer feedback or interaction. No such viewer feedback or viewer interaction is required in the invention claimed herein. This limitation of the present invention is captured in amended claim 1 as, “at a predetermined time and without viewer interaction, sending said stored embedded information and viewer information to a remote computer to allow said remote computer to construct said viewing record”. This limitation is not taught in Matheny. In fact as set forth in the passages of Matheny set forth above, Matheny teaches that the identities of viewers who provide correct answers to the question are therefore forwarded to server 220, within which is maintained a database of viewers and corresponding earned entitlements. Thus, without viewer feedback, Matheny doesn’t even store viewer identities in its database of those viewers have not provided valid feedback. Such a teaching in Matheny is directed away from the presently claimed invention that does not require such viewer interaction. Therefore, Matheny does not teach or suggest the invention presently claimed in amended claim 1.

Therefore, Applicant respectfully submits that at least for the reasons set forth above, independent claim 1 is allowable. In addition, because claims 2-10 present similar limitations as in claim 1 as argued above, Applicant submits that at least for the same reasons set forth above, claims 2-10 are also allowable and thus their rejections should be

withdrawn.

Applicant therefore respectfully requests withdrawal of the pending rejections and allowance of the pending claims.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Jim H. Salter at 408-406-4855 to facilitate prosecution of this application.

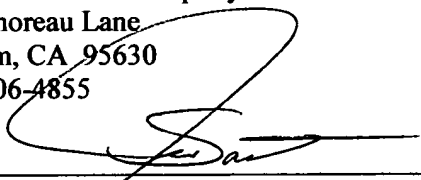
Respectfully submitted,

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Date February 15, 2007

By 
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15th day of February 2007.

Jim H. Salter

Name


Signature